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Application No.: 09/880,769

Docket No.: 60680-1647

**REMARKS/ARGUMENTS**

Applicant has carefully reviewed the Office Action dated November 7, 2003 (paper no. 9). Applicant thanks Examiner Pickard for her detailed review of the pending claims. By way of this Amendment, Claims 1, 8 and 16 have been amended and claim 7 has been canceled. No new matter has been added. Accordingly, claims 1-6, and 8-21 remain pending in this application. Applicant respectfully requests reconsideration of the present application in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. §102(b)

Claims 1-3, 7-9, 13 and 14 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,869,516 to Udagawa (hereinafter "Udagawa"). Applicant respectfully traverses the rejection.

Udagawa, as interpreted by the Examiner, discloses a gasket comprising at least one metal layer 25 having a metal ring 23 welded thereto over a welding bead 26. However, in view of the amendments to claims 1 and 8, Udagawa fails to teach each of the claim limitations as required under 35 U.S.C. §102(b).

Claims 1 and 8, as amended, recite a gasket comprising at least one through-hole and a welding bead, wherein the welding bead extends continuously around the at least one through-hole. Applicant has found that a welding bead that runs continuously around the through-hole advantageously seals the through-hole, especially for internal combustion engines where the combustion gas in the combustion chamber is under high pressure. In contrast, Udagawa teaches spot welding depressions 26 to connect outer plates 23, 24 and inner plate 25. *See col. 2, lines 66-67, col. 3, lines 12, 28, 36, and 41 and claims 1, 4 and 6.* Spot welding only occurs at depressions 26 and is not continuous around central hole 21.

For at least these reasons, Udagawa fails to teach each of the claim limitations as positively recited by Applicant in claims 1 and 8. Withdrawal of the rejection is respectfully requested.

Furthermore, claims 2 and 3 depend from patentably independent claim 1 and claims 9, 13 and 14 depend from patentable independent claim 8. For at least this reason claims 2, 3, 9, 13 and 14 are patentable.

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However, the dependent claims also contain independently patentable subject matter. By way of example, the Udagawa reference fails to disclose each limitation of claim 3, specifically that the at least one layer and the at least one metal ring are spaced from each other by a distance which varies around the at least one through-hole. Contrary to the Office action, the outer plates 23, 24 and inner plate 25 are held substantially parallel to each other by spot welding. *See col. 3, lines 1-2, 13-15, 29-31, 36-37, and 41-43.* While the depth of sealing bead 25a or depression 26 may vary, outer plates 23, 24 and inner plate 25 are spot welded together so that they remain substantially parallel to each other. Thus, the distance between outer plates 23, 24 and inner plate 25 does not vary around the central hole 21.

Accordingly, because the Udagawa reference fails to disclose each limitation of the claims, the Applicant respectfully requests allowance of claims 1-3, 8-9 and 13-14. Claim 7 has been canceled so the rejection is now moot.

#### Claim Rejections Under 35 U.S.C. §103

Claims 1-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,690,342 to Tanaka (hereinafter "Tanaka") in view of U.S. Patent No. 4,850,214 to Opprecht (hereinafter "Oprecht"). Applicant respectfully traverses the rejection.

The Examiner relies on Tanaka to disclose a gasket comprising a metal layer and a metal ring and Opprecht to teach welding. Based upon these references, the Examiner asserts that it would have been obvious to one of ordinary skill in the art looking to connect these pieces together via a weld to consider welding art teachings, such as Opprecht, and that the pieces would also be maintained in a spaced-apart relationship. However, if this assertion is taken to be true, it contradicts the teachings of Tanaka, rendering Tanaka non-functional. Tanaka discloses a metal substrate 1 formed into a predetermined shape having apertures 5, 6, 7 and 8. The metal substrate 1 further has full beads 9 and half beads 10. The ring-shaped shims 2 are attached to the metal substrate 1 by laser-welding so that they come into contact with the half beads 10 on a substrate surface 10a. *See col. 3, lines 17-31.* Thus, Tanaka can not be practiced with a space-apart relationship between the ring-shaped shims 2 and the substrate surface 10a of the metal substrate 1.

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In contrast, independent claims 1, 8 and 16 positively recite the feature of a welding bead that maintains the at least one metal layer and the at least one metal ring in a spaced-apart relationship. The Applicant has found that having the metal layer and the metal ring spaced apart from each other allows the welding bead to press the metal ring away from the metal layer, thus increasing the sealing capacity of the gasket. *See Specification page 3, lines 8-9.*

Accordingly, the Examiner has failed to establish prima facie obviousness because the Tanaka reference, in combination with the Opprecht reference, fails to teach each limitation of the claimed invention as required under 35 U.S.C. §103. Applicant respectfully requests withdrawal of the rejection for claims 1, 8 and 16.

Furthermore, claims 2-6 depend from patentably independent claim 1, claims 9-15 depend from patentable independent claim 8 and claims 17-21 depend from patentable independent claim 16. For at least this reason, claims 2-6, 9-15 and 17-21 are patentable. However, the dependent claims also contain independently patentable subject matter. By way of example, the Tanaka reference fails to disclose each limitation of claim 3, specifically that the at least one layer and the at least one metal ring are spaced from each other by a distance which varies around the at least one through-hole. Accordingly, Applicant respectfully requests withdrawal of the rejection for claims 2-6, 9-15 and 17-21.

Moreover, the discussion with respect to the rejections under 35 U.S.C. §102(b) is equally applicable for claims 1-21.

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**CONCLUSION**

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Applicant believes no fee is due with this response. However, if any fees are required in connection with the filing of this paper, permission is given to charge Account No. 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any question or comments, he is kindly urged to call the undersigned to facilitate prosecution.

Dated: January 7, 2004

Respectfully submitted,

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